



REENBLUM & BERNSTEIN, P.L.C.
Intellectual Property Causes
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Reston, VA 20191
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Attorney Docket No. P21821

In re application of : Thomas Thoroe SCHERB et al.

Serial No. : 10/073,917

Group Art Unit: 1731

Filed : February 14, 2002

Examiner: K. Hastings

For : MACHINE AND METHOD FOR THE MANUFACTURING OF A
FIBER MATERIAL WEB

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

RECEIVED
JUN 18 2002
TC 1700

Sir:

Transmitted herewith is an election with traverse in the above-captioned application.

- ☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
- ☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- ☐ A Request for Extension of Time.
- ☐ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 11	20*	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 3	3**	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

*If less than 20, write 20

**If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

☒ A Check in the amount of \$_____ to cover the *filing/extension* fee is included.

☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)

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Reg. No. 28,394

35,923

P21821.A02



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Thomas Thoroe SCHERB et al.

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ELECTION WITH TRAVERSE

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In response to the Examiner's restriction requirement of May 15, 2002, the time set for response being one month from the mailing date from the U.S. Patent and Trademark Office, i.e., June 17, 2002 (June 15, 2002 being a Saturday), Applicants hereby elect the invention of Group III, including claims 9 - 11. The above election is made with traverse for the reasons set herein below:

In the Restriction Requirement of May 15, 2002, the Examiner indicated that all claims (1 - 11) were subject to restriction under 35 U.S.C. § 121. The Examiner restricted the claimed invention into Group I, including claims 1 - 5, drawn to shoe pressing unit with nip length less than 60 mm, classified in class 162, subclass 358.3; Group II, including claims 6 - 8, drawn to web pressing process for at most 3 milliseconds, classified in class 162, subclass 205; and Group III, including claims 9 - 11, drawn to web pressing process for at

least 3.5 milliseconds, classified in class 162, subclass 205.

The Examiner asserted that the inventions of Group II (with Group III) and Group I were related as process and apparatus for its practice, and that the inventions are distinct from each other under M.P.E.P. § 806.05(e) because the "process as claimed can be used to practice another and materially different apparatus such as one with a soft rubber belt which extends the press nip; the method claims do not require a shoe press unit for example only; furthermore, the apparatus as claimed can be used to practice another and materially different process such as one wherein the time of pressing is different than that claimed in the method claims since the time of pressing depends on the speed the machine is operated at which is not an apparatus limitation."

The Examiner further asserted that the inventions of Groups II and III are drawn to independent and distinct inventions since each recites limitations that are mutually exclusive.

Applicants respectfully submit that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

While the Examiner has alleged a possible distinction between the two identified groups of invention, the Examiner has not shown that a concurrent examination of these groups would present a "serious burden" on the Examiner. In fact, the Examiner has

acknowledged that each individual group would be classified in the same class (class 162). Moreover, while the Examiner states that searching a single mutually exclusive feature in Groups II and III would be burdensome, there is no showing that such a search would be divergent or even that the search areas required to examine the invention of group I would not overlap into the search areas for examining the invention of groups II and/or III, and vice versa.

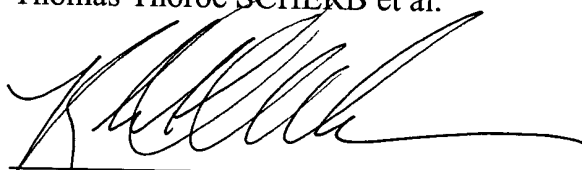
Applicants respectfully submit that the search for the combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group of invention is substantially the same, Applicants submit that no undue or serious burden would be presented in concurrently examining Groups I and II. Thus, for the above-noted reasons, and consistent with the office policy set forth above in M.P.E.P. § 803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicants have elected, with traverse, the invention defined by Group III, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

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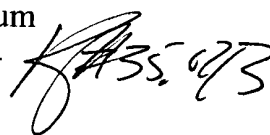
Should the Examiner have any questions or comments, she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Thomas Thoroe SCHERB et al.



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June 17, 2002

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